

### **REMARKS**

This responds to the Office Action mailed on September 2, 2005. By this amendment, no claims were amended, canceled, or added. As a result, claims 1-8 and 15-27 remain pending in this application. Reconsideration of this application in view of the following remarks is hereby requested.

#### **§102 Rejection of the Claims**

**Rejection:** Claims 1-8 and 15-27 were rejected under 35 USC § 102(e) as being anticipated by McAllister et al. (U.S. 2002/0186002 A1).

**Response:** A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. PPG Industries, Inc. V. Guardian Industries Corp., 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1, as amended, recites "...an element having a surface for electrically contacting a first plane; and a probe having a free end positioned in a second plane for electrically contacting the second plane." In the McAllister et al. reference, there is no element that contacts a first plane and a probe for electrically contacting the second plane. The contacts 132 and 132 the Examiner cites for teaching this recitation are actually located in the same physical plane.

Looking more closely at the McAllister et al. reference, the interface board 119 has a plurality of holes 126 therein. "Resilient coaxial probe connectors (pins) 130 are located in selected holes 126 for connecting to signal pads." In addition, "Double ended, so-called 'POGO' ground pins 131 are located (to preferably define a small ground loop with respect to the measured signal) in selected holes 126 for providing a return or ground connection." (See last half of paragraph 0032 of McAllister et al.) The McAllister et al. reference goes on to state that "The interconnect circuit board 120 comprises a multi-layer printed circuit board having pads

132 (which connect with pins 130 and 131) **at one surface 134 thereof** which are connected by vias 136 to traces 138 at various layers of the circuit board 120 and to pads 140 at the other surface 142 of the circuit board 120.” (Emphasis added, see paragraph 0033 of McAllister et al.) Two pads 132 at the same surface are in the same plane rather than in different planes. As a result, claim 1 overcomes the Examiner’s rejection under 35 USC § 102(e) as being anticipated by the McAllister et al. reference (U.S. 2002/0186002 A1) for the reason set forth above.

Claims 2-8 each depend from claim 1 and include its limitations. As a result, claims 2-8 overcome the Examiner’s rejection under 35 USC § 102(e) as being anticipated by the McAllister et al. reference (U.S. 2002/0186002 A1).

Claim 15 recites “...a second test probe...comprising: an element having a surface for contacting a first plane; and a probe having a free end positioned in a second plane adapted to contact an electrical element in the second plane.” As set forth above, the two pads 132 that the Examiner contends were in different physical planes at the same surface as admitted in the McAllister et al. reference. Two pads at the same surface are in the same plane rather than in different planes. As a result, claim 15 overcomes the Examiner’s rejection under 35 USC § 102(e) as being anticipated by the McAllister et al. reference (U.S. 2002/0186002 A1) for the reason set forth above.

Claims 16, 17 and 22 each depend from claim 15 and include its limitations. As a result, claims 16, 17 and 22 overcome the Examiner’s rejection under 35 USC § 102(e) as being anticipated by the McAllister et al. reference (U.S. 2002/0186002 A1).

Claim 18 recites “...contacting a first pad on the device under test located in a first plane; and contacting a second pad on the device under test in a second plane substantially simultaneously as contacting the first pad.” As discussed above, the pins 130 and 131 of the McAllister et al. reference contact two pads 132 on the same surface and in the same physical plane. Therefore, McAllister fails to teach contacting a first pad in a first plane and a second pad in a second plane substantially simultaneously. Accordingly, claim 18 overcomes the Examiner’s rejection under 35 USC § 102(e) as being anticipated by the McAllister et al. reference (U.S. 2002/0186002 A1) for the reason set forth above.

Claims 19-21 each depend from claim 18 and include its limitations. As a result, claims 19-21 overcome the Examiner's rejection under 35 USC § 102(e) as being anticipated by the McAllister et al. reference (U.S. 2002/0186002 A1).

Claim 23 recites "...contacting a plurality of pads located in a first plane on the device under test; and contacting at least one other pad in a second plane on the device under test substantially simultaneously as contacting the plurality of pads located in the second plane." As discussed above, the pins 130 and 131 of the McAllister et al. reference contact two pads 132 on the same surface and in the same physical plane. Therefore, McAllister fails to teach contacting a first pad in a first plane and a second pad in a second plane substantially simultaneously. Accordingly, claim 23 overcomes the Examiner's rejection under 35 USC § 102(e) as being anticipated by the McAllister et al. reference (U.S. 2002/0186002 A1) for the reason set forth above.

Claims 24-27 each depend from claim 23 and include its limitations. As a result, claims 24-27 overcome the Examiner's rejection under 35 USC § 102(e) as being anticipated by the McAllister et al. reference (U.S. 2002/0186002 A1).

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 373-6977) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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